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(Weatherford) Wong Cabello Lutsch Rutherford &
Brucculeri LLP
20333 Tomball Parkway, 6th floor
Houston TX 77070

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DEC 01 2010

OFFICE OF PETITIONS

In re Application of: :
David M. Tucker et al :
Application No. 10/716,248 : PETITION DECISION
Filed: November 17, 2003 :
Attorney Docket No. 205-0034USRI :

This is a decision on the petitions under 37 CFR 1.183 filed August 4, 2010, which is being treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.64.

The petitions are dismissed.

Petitioner requests waiver of the signature requirement of a reissue application supplemental declaration. The originally named inventor, David M. Tucker, who signed the originally filed declaration, is allegedly refusing to sign the supplemental reissue declaration. 37 CFR 1.47 are directed to situations where the inventor refuses to execute an application for patent, or cannot be found. However, petitions under 37 CFR 1.47 are only applicable to the initial execution of an original oath or declaration and are not applicable to supplemental oaths or declarations by the originally signing inventor. In such circumstances, the USPTO will consider a petition under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.64 that each of the actual inventors execute the supplemental oath or declaration.

MPEP 603 states in part:

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a).

In discussing waiver requirements under 37 CFR 1.183, the Office is guided by proof similar to that required when an applicant is unavailable or refuses to sign. Petitioner indicates that the non-signing inventor Tucker refuses to sign the supplemental declaration.

MPEP 409.03(d)(II) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

The petition indicates that nonsigning inventor Tucker instructed petitioner that he could only be contacted through his attorney, Wayne Clawater. According to the petition, Clawater acknowledged a first email sent to him but has not responded to any further emails.

Petitioner should mail a complete copy of the supplemental reissue declaration and amended claims to Clawater's mailing address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach attorney Clawater continue to fail, then applicant will have established that the inventor cannot be reached (through his attorney) after diligent effort or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts. It is important that the forthcoming communication contain statements of fact as opposed to conclusions.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Director for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571)273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to Carl Friedman at (571) 272-6842.



David Bucci
Petitions Examiner
Office of Petitions